

REMARKS

This Response is submitted in response to the Office Action of August 1, 2006. Claims 1-17 and 23-44 are pending. Claims 1-2, 23, 27 and 29 are amended and Claims 45 and 46 are added by this response. No new matter is introduced by these amendments. A Request for Continued Examination and a Petition for Two-Month Extension of Time are submitted herewith. The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

Mailing Address

Please note the mailing address has not been changed in accordance with the Power of Attorney by Assignee and Express Revocation of Prior Powers appointing the attorneys and agents identified with customer number 29180 to prosecute and transact all business in the United States Patent and Trademark Office for this application, submitted on April 27, 2006. As a result, the Office Action did not reach Applicants with sufficient time to prepare a response before fees for extension of time would be due. To prevent a recurrence of this problem, please note the new correspondence address (the address associated with customer number 29180) and the new attorney docket number.

35 U.S.C. 112 Rejections

Claims 1-17 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Office Action stated that Claim 1 recites that game data “can” include character data and further states that the Claim 1 “does not affirmatively claim that it does include character data.” Applicants have amended Claim 1, to affirmatively claim that the compatible game data is part of a set of game data and respectfully submits that this rejection is overcome.

35 U.S.C. 103(a) Rejections

Claims 1-12, 14-15 and 30-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. JP 2000308,763 (“Ebisawa”) in view of the Diablo

video game from Blizzard Entertainment ("Diablo"). Claims 13, 16-17, 23-29 and 35-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa in view of Diablo in further view of U.S. Patent No. 5,971,855 ("Ng"). Applicants respectfully disagree.

Ebisawa discloses a handheld game in which a bar code reader scans bar codes to further the game. Bar codes can be associated with products and companies, and bar codes are associated with characters which can do battle. However, Ebisawa does not disclose or suggest groups or tribes of characters which are controllable by some user and do not engage their fellow group or tribe members in contests or battle. Further, the Office Action admits that "Ebisawa does not teach the division of characters into groups where members of the group do not attack each other." For at least these reasons, Applicants respectfully submit that Ebisawa does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

Diablo is a computer game in which the player's character searches through areas of the game world, encountering and doing battle with various monsters. The Office Action states that the monsters in the monster group do not attack each other and only attack the player's character. However, the monsters in the monster group are not controllable by any user of the Diablo game. For at least these reasons, Applicants respectfully submit that Diablo does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

Further, Applicants respectfully submit there is insufficient motivation to combine Ebisawa and Diablo. Motivation to combine cannot come from the invention itself, and to prevent such hindsight-based obviousness analysis, "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references" is required. In re

Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999). Further, a finding of motivation to combine must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2D (BNA) 1430, 1433 (Fed. Cir. 2002). See also M.P.E.P. § 2143.01. Even if the references relied upon are known in the art and combination of the references would be “well within the ordinary skill of the art at the time the claimed invention was made,” a rejection based on obviousness is still improper without some objective reason to combine the teachings of the references. M.P.E.P. § 2143.01.

It is respectfully submitted that the Office Action does not point out any objective motivation to combine the references. Instead, the Office Action merely states that it would have been obvious to combine Ebisawa with Diablo “in order to implement an adventure game where players get the enjoyment of killing monsters.” However, it is respectfully submitted that Ebisawa does not provide motivation to implement such a game. It is also respectfully submitted that Diablo does not provide motivation to scan in characters from bar codes. The Office Action appears to impermissibly be relying on hindsight by pointing to the advantages of an embodiment of the invention itself as motivation for making the combination. It is respectfully submitted that there simply is no motivation to “implement an adventure game where players get the enjoyment of killing monsters” in the system of Ebisawa unless the motivation is impermissibly provided by the present application. For at least these reasons, it is respectfully submitted that it is improper to combine Ebisawa with Diablo.

For at least these reasons, Applicants respectfully submit that Claim 1 and its dependent claims, are each patentably distinguished over Ebisawa in view of Diablo and are in condition for allowance.

Ng discloses a game device which can communicate with a similar game device for interactive play between the two devices. However, similar to Ebisawa and Diablo, Ng does not disclose or suggest that the compatible game data is part of a set of game data, the set of game data including character data for a plurality of characters, wherein at least two of the plurality of characters are associated with a group, and wherein a third of the plurality of characters is not associated with the group, and wherein the at least two of the plurality of characters do not engage each other in battle, and wherein the at least two characters are controllable by at least one user as in Claim 1.

For at least these reasons, Applicants respectfully submit that Claim 1 and its dependent claims are each patentably distinguished over Ebisawa in view of Diablo in further view of Ng and are in condition for allowance. For similar reasons, Applicants respectfully submit that Claims 23 and 29, and their respective dependent claims are each patentably distinguished over Ebisawa in view of Ng and are in condition for allowance.

Further, with respect to Claim 45, none of Ebisawa, Diablo and Ng disclose or suggest an electronic circuit operable to determine whether a contest will be staged, wherein if the game data is not compatible game data and the bar code was scanned twice, the contest will be staged. For at least this reason, Applicants respectfully submit that Claim 45 is patentably distinguished over Ebisawa in view of Diablo in further view of Ng and is in condition for allowance.

Further still, with respect to Claim 46, none of Ebisawa, Diablo and Ng disclose or suggest that if the game data is not compatible game data and the bar code is scanned only once, the contest will not be staged. For at least this reason, Applicants respectfully submit that Claim 46 is patentably distinguished over Ebisawa in view of Diablo in further view of Ng and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and Applicants respectfully request that a Notice of Allowance be issued. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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Dated: December 6, 2006